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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,321	03/13/2001	Scott A. Hermreck	580745.004	1791

758 7590 10/20/2006

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EXAMINER

LANEAU, RONALD

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/805,321	Applicant(s) HERMRECK ET AL.	
	Examiner Ronald Laneau	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-29 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-29 and 40-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The response filed on 7/28/06 has been entered. Claims 1, 3-29, 40-49 remain pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-29 and 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price (US 2002/0120539 A1) in view of Hodges (US 2002/0116290 A1) and further in view of TurboTax.

As per claims 1, 8-22, 24-29, 40-44, 48 and 49, Price discloses a computer-implemented method for tracking charitable donations, said method comprising the steps of: storing in memory data indicative of one or more non-cash donatable items (page 2, [0020]); prompting a user to select one or more of said non-cash donatable items that has been charitably donated in one of said tax years and to indicate the tax year in which the selected non-cash donatable item was donated (page 4, [0035] – [0036]). Price does not explicitly disclose a valuation of non-cash donation but Hodges discloses a valuation associated with each said non-cash donatable item for a current tax year and at least one previous tax year (page 1, [0007]). Neither Price nor Hodges discloses importing the valuation but TurboTax discloses an available means of electronically retrieving the tax-deductible valuation associated with said selected non-cash donatable item for the indicated tax year from memory (inherent in importing

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data, page 12); and storing said selected non-cash donatable item, indicated tax year and retrieved tax-deductible valuation in said memory in association with each other (from the system's server memory).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system of valuating non-cash donation as taught by Hodges into the system of Price because it would facilitate the donations of IP assets (non-cash donation) from potential donors to potential donees. And it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system of importing data from memory as disclosed in the Turbo book into the system of Price because it would make tracking tax records easier.

As per claims 3-7, 23, 45 and 47, the above rejection applies. Furthermore, Price discloses receiving sales periodically from one or more partner servers, wherein said partner servers are programmed to electronically collect sales data of item sold and calculating a tax-deductible valuation in accordance with tax authority guidelines for each of said non-cash donatable items based on said sales data (see abs, page 4, [0035] – [0036]). Price does not explicitly disclose exporting the category totals electronically into an income tax return but TurboTax an available means of electronically retrieving the tax-deductible valuation associated with said selected non-cash donatable item for the indicated tax year from memory (inherent in importing data, page 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system of importing data from memory as disclosed in the Turbo book into the system of Price for the same reasons given above.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 3-29 and 40-49 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Price does not disclose "storing in memory data indicative of one or more non-cash donatable items and a tax-deductible deductible valuation associated with each said non-cash donatable item for a current tax year and at least one previous tax year." In response to Applicant's arguments, the newly added reference (Hodges) is used to disclose such elements of the claimed invention. Furthermore, Applicant argues that the examiner fails to make a prima facie case of obviousness since there is no suggestion or motivation to modify the references or combine reference teachings so as to arrive at the claimed invention. In response to applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Claims 1, 3-29, 40-49 remain rejected.

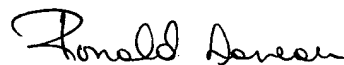
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 7:30 - 3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau
Primary Examiner
Art Unit 3714

10/13/06

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